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UNITED STATES PATENT AND TRADEMARK OFFICE

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09/318,917	05/26/1999	GERALD B. HALT JR.	HAL2-PT001.1	2067

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EXAMINER
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ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 12/22/2003   17

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/318,917	HALT, GERALD B.
	Examiner	Art Unit
	Cheryl Lewis	2177

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>9/25/03, paper no. 16</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-6</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-6</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1.   This Office Action is in response to the applicant's communication received on

September 25, 2003, paper no. 16.

2.   Claims 1-6 are presented for examination. Applicant has cancelled claim 7,

Amendment C, filed on June 21, 2002, paper no. 10.

3.   Applicant has amended claims 1 and 2, Amendment E, September 25, 2003,

paper no. 16.

4.   Applicant's arguments received on September 25, 2003 have been fully

considered but they are not deemed to be persuasive.

Specification

5.   The Specification is objected to because the Specification is missing "Brief

Description of the Drawings as required by the arrangement of the Specification, MPEP

(608-01).

Response to Arguments

6. (a) The applicant argues that 'In rejecting claim 1, the Examiner has submitted that

"Hartman teaches a tailored web page to an individual user without requiring a user to

disclose information that identifies the user," as in claim 1…Referring to Figure 8B of

Hartman, however, it is clear that users are specifically required to identify themselves.

In fact, from Figures 8A-8C of Hartman, it is also clear that, in further contrast to claim 1, users are required to provide much more than personal characteristics.', page 5, lines 7-13.

(a1)   In response to the above recited argument. The Examiner believes that Hartman (5,060,411) teaches a tailored web page to an individual user without requiring a user to disclose information that identifies the user. Hartman teaches a client system is provided with an identifier that identifies a customer. The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item (column 2, lines 52-57). Hartman further teaches the sever system 210 includes a server engine 211, a client identifier/customer table 212, various Web pages 213, a customer database 214, an order database 215, and an inventory database 216. The sever engine receives HTTP requests to access Web pages identified by URLs and provides the Web pages to various client systems. Such an HTTP request may indicate that the purchaser has performed the single action to effect single-action ordering. The customer database contains customer information for various purchasers or potential purchasers. The customer information includes purchaser-specific order information such as the name of the customer, billing information, and shipping information. The customer identifier/ customer table 212 contains a mapping from each client identifier, which is a globally unique identifier that uniquely identifies a client system, to the customer last associated with the client system. The client system 220 contains a browser and its assigned client identifier (col. 5, lines 59-67, column 6, lines 1-4 and 7-

12). As indicated above, Hartman teaches the user's identity is pre-existing and

predefined within the client system. The user or client's identity is stored at a client

system. The client system contains a browser and its assigned client identifier.

Nowhere does Hartman teach or suggest that a user or client is required to disclose

information that identifies the user or client as an individual. Again, the user's identity is

predefined by (1) a client system containing a browser and its assigned client identifier

and (2) the client identifier/customer table 212 contains a mapping from each client

identifier, which is a globally unique identifier that uniquely identifies a client system.

Regarding figures 8A-8C, the user provides personal characteristics pertaining to

certain data elements which may have changed overtime that requires further updating.

For instance, the user's personal characteristics comprise name, middle initial, and last

name. However, the user's personal characteristics are followed by financial info,

employment info, and education info. These particular personal characteristics may

require some updating over time.

(b)   Next, the applicant argues '...It is well established, however, that cookies simply

identify users who have previously registered or visited a web site. That is, a cookie

does not enable the content of a particular web site to be presented in accordance with

a user's personal characteristics as in the claim 1.' (page 5, lines 15-19).

(b1)   In response to the above recited argument. Hartman comprises a cookie,

wherein the cookie provides <u>customized</u> web content. A cookie is stored locally in a

preference file by a browser. The stored preference file contains a unique client

identifier and customized or preference information with regard to the customer of the

client system. Also, the browser is also stored on the client system. Further, a cookie

can store preference information about the user that is collected by the web server

based on the user's browsing choices. This process of collecting information about the

user's preferences is performed "automatically", without requiring manual input of

personal information from the user. Hartman teaches a data file which contains a user's

preference, a user's own personal preferences. The personal preferences of a user

include the user's interest, likes, dislikes, personal characteristics, etc.

The applicant continues to argue a user's personal characteristics. However, the

applicant's claim is broadly claimed with reference to personal characteristics. Perhaps

the applicant should consider being more specific with the type of personal

characteristics that is actually being claimed. A specified set of personal characteristics

could overcome the present rejection. Likewise, the applicant fails to argue and show

support in the Specification for the type of personal characteristics that are being

claimed.

(c)   The applicant argues 'In support of this assertion, the Examiner points to the

description in column 4, lines 4-58. In this description, however, it is clear that the

description simply refers to product descriptions and the implementation of a single-

action ordering button.' (page 6, lines 2-5).

(c1)   In response to the above recited argument. Within column 4, lines 4-58,

Hartman teaches and shows within a web page the type of products that a client

prefers. The products that are associated with the client are the client's own personal

preferences for these selected items. The selected preferred products of the client are

associated with a purchaser identification (i.e., personal characteristic), shipping

address (i.e., personal characteristic), a summary description sections for the types of

items that are preferred by the client or purchaser, etc.

(d)   Again, the applicant argues '...the Examiner submits that the elements shown in

Figure 1A disclose the discrete elements of claim 1 and that the designated fields in

Figures 8A-8C disclose the personal characteristics of claim 1....', (page 6, lines 8-11).

(d1)   In response to the above recited argument. Again, as stated above these

discrete elements are associated with the client's personal preference or interest for the

type of items that a client prefers. The information input by the user depicts the

applicant's claimed "plurality of user-selectable fields". The applicant's claim user-

selectable fields having personal characteristics. Likewise, Hartman teaches the

claimed user-selectable fields having personal characteristics and personal preference

for selected products of interest to the specific client. The applicant claims "user-

selectable fields". These fields must comprise some sort of manipulation by a user in

an effort to perform a type of data "selection" to these fields. Are these fields user

controlled for input, data manipulation, or is there a type of selection performed on these

fields which makes the "user-selectable" field means unique than any other fields

presented in a web page interfacing scheme?

(e)   Finally, the applicant's argue 'The content that is displayed in not a function of a

user's personal characteristics, but rather is simply the content as it was entered by the

user.....In claim 2, there is at least one user-selectable field base on which a selected

data stream is outputted...', (page 7, lines 11-17).

(e1)   In response to the above recited argument. Robertson does display a selected

data stream and display requested personal characteristic information. Figure 7 of

Robertson depicts a user graphical interface, wherein a plurality of selectable data

streams are displayed including a users own personal characteristics. Robertson uses

a personal contact manager. The personal contact manager identifies the personal

preferences of characteristics of a registered user.

The remaining dependent claims 3-6 each include claim limitations

corresponding substantially to the above-discussed claim limitations for independent

claims 1 and 2 and are also addressed by the above remarks.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122 (b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.   Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Hartman et al.

(Pat. No. 5,960,411 filed 9/12/1997, hereinafter Hartman).

9.   Regarding Claim 1, Hartman teaches a method and system for placing a

purchase order via a communication network.

The method and associated system for placing a purchase order via a

communication network as taught or suggested by Hartman includes:

a data file (col. 6, lines 5-16, 'The client system 220 contains a browser and its

assigned client identifier. The client identifier is stored in a file, referred to as a "cookie."

In one embodiment, the server system assigns and sends the client identifier to the

client system once when the client system first interacts with the server system.') having

a plurality of user-selectable fields (figure 1, element 101 'Summary Description of Item',

element 104 'Detail Description of Item'), each field for describing a personal

characteristic of a user (col. 9, lines 8-53, 'Figure 8A, elements A: Customer Name &

Address, B: Customer Financial Info, C: Customer Employment Info; and D: Customer

Education Info'); and means for automatically transmitting a data file (col. 6, lines 5-16,

'The client system 220 contains a browser and its assigned client identifier. The client

identifier is stored in a file, referred to as a "cookie." In one embodiment, the server

system assigns and sends the client identifier to the client system once when the client

system first interacts with the server system.') upon initially accessing a web page (col.

6, lines 62-64, 'The server engine receive HTTP requests to access Web pages

identified by URLs and provides the Web pages to the various client systems.'); web

page portion comprising data organized into a plurality of discrete sections (col. 4, lines

5-12, Figure 1A, elements 101-104, '...Web page contains a summary description

section 101, a shopping cart section 102, a single-action ordering section 103, and a

detailed description section 104.'), each section having a plurality of mutually exclusive

subsections (Figure 1A, elements 103-103d, col. 4, lines 35-41, 'The single-action

ordering section contains a single-action ordering button 103a ('Buy item and ship to:'),

purchaser identification <u>subsection</u> 103b (John Doe at home), and single-action

ordering information <u>subsections</u> 103c ('Check shipping address or change 1-click

settings') and 103d (Lean more about 1-click express ordering); receiving a data file

(col. 6, lines 11-16, 'The client system 220 contains a browser and its assigned client

identifier. The client identifier is stored in a file, referred to as a "cookie." In one

embodiment, the sever system assigns and sends the client identifier to the client

system once when the client system first interacts with the server system.'); analyzing a

plurality of user-selectable fields of a data file (col. 9, lines 8-53, 'FIG. 8A illustrates an

outline format of a sample form to be filled in. The same form contains various sections

identified by letters A, B, C, and D. When the user selects the start button, then section

A expands to include the data entry fields for the customer name and address.');

selecting one of the mutually exclusive subsections for each section in response to the

analysis (col. 4, lines 4-19 & 26-54, 'This example single-action ordering section allows

the purchaser to specify with a single click of a mouse button to order the described

item. Once the purchaser clicks the mouse button, the item is ordered, unless the

purchaser then takes some action to modify the order.'); web page presents a plurality

of sections to a user of which is related one or more of the personal characteristics (col.

7, lines 5-14, 'This information may include the customer's name, a shipping address

moniker selected by the purchaser (e.g., "at home"), and the last five digits of a credit

card number or a nickname selected by the purchaser.').

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
>
> or described as set forth in section 102 of this title, if the differences between the
>
> subject matter sought to be patented and the prior art are such that the subject
>
> matter as a whole would have been obvious at the time the invention was made
>
> to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was
>
> made.

11.   The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating

         obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

12.   Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Robertson (Pat. No. 6,269,369 filed 11/2/1997) and Hartman et al. (Pat. No. 5,960,411).

13.   Regarding Claim 2, Robertson teaches generating an information user profile

(Abstract, lines 1-7, '...users of networked clients maintain and update a set of user

information which is stored in a relational database on a networked server. The

personal contact manager system allows each user to specify on an individual basis

which of their contacts are permitted to access respective datums of their user

information.') having at least one user-selectable data field (col. 6, lines 58-67, 'Users

can enter information in these GUI in various data fields. In the preferred embodiment,

these fields include: Name 560-2, Home Address 560-4, Home Phone 560-6', etc.), a

user-selectable data field for identifying characteristics particular to a user,

characteristics selected from the group of age, race, sex, income and native language

(col. 6, lines 58-67, 'Users can enter information in these GUI in various data fields. In

the preferred embodiment, these fields include: Name 560-2, Home Address 560-4,

Home Phone 560-6, Work Address 560-8, Work Phone 560-10, Birthday 560-12..', col.

10, lines 61-64, 'The second user's birthday and birth year 634-8 are displayed only if

the second user gave the first user Birthday Notification permission.'); automatically

transmitting information user profile (col. 6, lines 58-67, 'Users can enter information in

these GUI in various data fields. In the preferred embodiment, these fields include:

Name 560-2, Home Address 560-4, Home Phone 560-6', etc..) over the Internet (col. 4,

lines 27 and 28, '...in FIG. 5, the preferred embodiment follows a standard Internet

architecture, in which client computers 370 and a server computer 330 are connected

via the World Wide Web 360...') to the information provider upon accessing the

information provider (col. 2, lines 5-40, col. 4, lines 27-41, col. 7, lines 20-27, col. 9,

lines 57-67, col. 10, lines 1-53, 'The server computer system 330 runs server software

342, including the network-computer-based personal contact manager 343 of the

present invention, which interacts with the client computers 370 and a user information

database 340. In a commercial embodiment of the present invention, the personal

contact manager 343 is the heart of a Web-based personal contact management

service called PlanedAll.'); and analyzing information user profile (col. 10, lines 1-53,

'The information in each user's personal address book is customized for that user, as

described below. Each first user's personal address book contains information about

each second user who has given the first user permission to view information in the

second user's personal data record 636.'); for each of N discrete data streams means

(col. 6, lines 58-67, 'Users can enter information in these GUI in various data fields. In

the preferred embodiment, these fields include: Name 560-2, Home Address 560-4,

Home Phone 560-6', Work Address 560-8, Work Phone 560-10, Birthday 560-12, High

School 560-14,...') for selecting one data stream from among a plurality of mutually

exclusive data streams located within each of the N discrete data streams (col. 6, lines

58-67, 'Users can enter information in these GUI in various data fields. In the preferred

embodiment, these fields include: Name 560-2, Home Address 560-4, Home Phone

560-6', Work Address 560-8, Work Phone 560-10, Birthday 560-12, High School 560-

14,...') and outputting selected data stream (col. 11, lines 60-67, '...the member update

pseudo GUI 650 shown in FIG. 11, if one or more members has affiliated with a group

with which the first user is also affiliated, a text description 650-14 will alert the first user.

The name of the second user, the name of the group in which the first and second users

share an affiliation...'), the selection being in response to an analysis of the received

information user profile (col. 6, lines 6-67, col. 7, lines 1-67, 'In the data field Year of

College Enrollment 560-22, the user enters the beginning date of the affiliation with the

group specified in the data field College 560-20. In the data field College Graduation

Year 560-24, the user enters the ending date of the affiliation with the group specified in

the data field College 560-20.', col. 8, lines 30-47, 'Several types of data field

permission are listed, each with a check box to the left enabling the first user to select or

deselect the permission type. For example, to grant the second user 600-4 permission

to view the information from the first user's personal data record indicated by the

permission type denoted "Crossing Paths Notification Permission,"...').

Robertson discloses a web server comprising means for receiving an information

user profile (col. 6, lines 40-67), however Robertson does not expressly teach a web

page unit.

Hartman teaches a web page unit comprising means for receiving an information

profile (figure 2, element 213 'Various Web pages, col. 5, lines 1-8 & 56-66).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the method of Robertson with the web page unit of

Hartman because Hartman's web page unit enables a server system sending to a client

system an assigned client identifier and an HTML document in order to identify the

client and the client's items ordered and selected through a purchasing process over the

internet, wherein the web page provides a display of client identifier information and

items ordered for purchase with a detailed description.

14.   Regarding Claim 3, Robertson teaches an information provider (col. 4, lines 27

and 28, '...in FIG. 5, the preferred embodiment follows a standard Internet architecture,

in which client computers 370 and a server computer 330 are connected via the World

Wide Web 360...', col. 2, lines 5-40, col. 4, lines 27-41, col. 7, lines 20-27, col. 9, lines

57-67, col. 10, lines 1-53, 'The server computer system 330 runs server software 342,

including the network-computer-based personal contact manager 343 of the present

invention, which interacts with the client computers 370 and a user information

database 340. In a commercial embodiment of the present invention, the personal

contact manager 343 is the heart of a Web-based personal contact management

service called PlanedAll.') includes a plurality of data streams (col. 6, lines 58-67, 'Users

can enter information in these GUI in various data fields. In the preferred embodiment,

these fields include: Name 560-2, Home Address 560-4, Home Phone 560-6', etc..),

data stream including an information identifier for identifying the type of information

provided by the data stream (col. 6, lines 58-67, 'Users can enter information in these

GUI in various data fields. In the preferred embodiment, these fields include: Name

560-2, Home Address 560-4, Home Phone 560-6', etc..).

15.   Regarding Claim 4, Robertson teaches the data streams may be individually

linked (col. 9, lines 30-47, col. 12, lines 37-44, '...FIG. 11, if a second user has initiated

a link to a first user, the first user will be automatically notified 650-18 that a link has

been made. For each second user that has initiated a link, the user's name 650-20 is

shown.').

16.   Regarding Claim 5, Robertson teaches the content of the data stream changes

on a basis set by an information provider (col. 7, lines 1-67, col. 12, lines 25-44, 'If the

first user wishes to add contact information to his personal address book for any of the

second users listed 650-16...In another portion of the member update pseudo GUI 650

shown in FIG. 11...').

17.   Regarding Claim 6, Robertson teaches the data stream is tailored to one of the

data fields (col. 6, lines 58-67, 'Users can enter information in these GUI in various data

fields. In the preferred embodiment, these fields include: Name 560-2, Home Address

560-4, Home Phone 560-6', Work Address 560-8, Work Phone 560-10, Birthday 560-12,

High School 560-14,...', col. 7, lines 1-67).

18.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

NAME OF CONTACT

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cheryl Lewis whose telephone number is (703) 305-

8750. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Breene can be reached on (703) 305-9790. The fax phone number

for the organization where this application or proceeding is assigned is (703) 872-9306.

(703) 746-5651 (Use this FAX #, only after approval by Examiner, for

"INFORMAL" or "DRAFT" communication. Examiners may request that a formal

paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

Cheryl Lewis
Patent Examiner
December 12, 2003

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100